

REMARKS:

Status Of Claims

Claims 1-42 were previously pending. Claims 1, 10, 17, 27, and 35 have been amended. Thus, claims 1-42 are currently pending in the application with claims 1, 10, 17, 27, and 35 being independent.

Office Action

In the Office Action, the Examiner rejected claims 1, 5, 10, 11, 17-19, 23, 27-31, and 35-38 under 35 U.S.C. § 102(e) as being anticipated by Gould et al., U.S. Patent Application Publication No. 20040106404. The Examiner rejected claims 1-42 under 35 U.S.C. § 103(a) as being unpatentable over Robinson et al., U.S. Patent No. 6,381,538, in view of Gould. Applicant respectfully submits that the currently pending claims distinguish the present invention from Robinson, Gould, and the other prior art references of record, taken alone or in combination with each other.

Legal Discussion of Obviousness

Obviousness can be a problematic basis for rejection because the Examiner, in deciding that a feature is obvious, has the benefit of the applicant's disclosure as a blueprint and guide, in which light even an exceedingly complex solution may seem easy or obvious. In contrast, one with ordinary skill in the art would have no such guide. Furthermore, once an obviousness rejection has been made, the applicant is in the

exceedingly difficult position of having to prove a negative proposition (i.e., non-obviousness) in order to overcome the rejection.

For these reasons, the law places upon the Examiner the initial burden of establishing a *prima facie* case of obviousness. If the Examiner fails to establish the requisite *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955 (Fed. Cir. 1993). Only if the Examiner's burden is met does the burden shift to the Applicant to provide evidence to refute the rejection.

In meeting this initial burden, the Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Thus, the Examiner is required to perform the "critical step" of casting his or her mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *See, e.g., W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303 (Fed. Cir. 1983).

Rejections on obviousness grounds also cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329 (Fed. Cir. 2006). The factual inquiry performed by the Examiner in issuing an obviousness rejection must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001 (Fed. Cir. 2001). The prohibition against conclusory examination is as much rooted in the Administrative

Procedure Act, which ensures due process and non-arbitrary decision-making, as it is in § 103. *In re Kahn*, 441 F.3d at 988.

Thus, three criteria must be satisfied by the Examiner in order to establish a *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the combination of references must teach or suggest all the claim limitations. See MPEP § 706.02(j), citing *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). This "motivation-suggestion-teaching" requirement protects against the entry of hindsight into the obviousness analysis, a problem which § 103 was meant to confront. *In re Kahn*, 441 F.3d at 988.

As stated in MPEP §2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

However, an Examiner's mere identification in the prior art of each individual element claimed is insufficient to defeat the patentability of a claimed invention without a proper suggestion to combine or modify the elements. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also

suggests the desirability of the combination. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125 (Fed. Cir. 1984). This "motivation-suggestion-teaching" requirement protects against the entry of hindsight into the obviousness analysis, a problem which § 103 was meant to confront. *In re Kahn*, 441 F.3d at 988.

In presenting the suggestion or motivation to combine prior art references, the Examiner may not resort to broad and conclusory statements; as such statements are not "evidence" of anything. *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313 (Fed. Cir. 2000). The suggestion to make the claimed combination must be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F.2d at 490. If the Examiner's proposed combination renders the prior art invention unsatisfactory for its intended purpose, or changes its principal of operation, there can be no suggestion or motivation to form the combination—and thus no *prima facie* case of obviousness. See MPEP § 2143.01; *In re Gordon*, 733 F.2d at 902.

Claims 1 and 10 each now recite "wherein the receiver is selected from the group consisting of an ADS-B receiver and a UAT datalink receiver". Claim 17 now recites "receiving update information in the form of digital data, via a radio signal from a remote transmitter to a receiver selected from the group consisting of an ADS-B receiver and a UAT datalink receiver, with an avionics device". Claim 27 now recites "transmitting a radio signal to a receiver selected from the group consisting of an ADS-B receiver and a UAT datalink receiver via a remote transmitter having packaged update information therein to a number of avionics devices, thereby updating software resident on the avionics devices".

Claim 35 now recites "receiving data, in the form of a radio signal from a remote transmitter to a receiver selected from the group consisting of an ADS-B receiver and a UAT datalink receiver, at an avionics device".

In contrast, the Examiner acknowledges that neither Gould nor Robinson discloses receiving software updates over either an ADS-B receiver or a UAT datalink receiver in the manner claimed. Rather, on page 4 of the May 31, 2006 Office Action, the Examiner simply asserts "it would have been readily apparent for one skilled in the art that any receiver including well known and commercially available ADS-B receiver and UAT datalink receiver can be employed in their system to receive transmitted data". However, such unsupported assertions are not "evidence" of obviousness. Furthermore, Gould teaches away from the Examiner's proposed modification. Therefore, the present obviousness rejections are improper, and cannot be sustained.

It is well settled that "[t]he totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is evidence of nonobviousness". MPEP § 2145 citing *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986). At the time of Applicant's invention, ADS-B and UAT datalink receivers were only used in well known and very specific applications. To use such receivers in the manner presently claimed would have been quite novel and nonobvious. This is evidenced by the prior art cited by the Examiner. Gould clearly shows his invention being employed on commercial airliners which at that time were already commonly equipped with both ADS-B and UAT datalink receivers. Yet, nowhere does Gould teach or suggest receiving software updates over

either ADS-B or UAT datalink receivers, as presently claimed. In fact, Gould explicitly teaches employing a completely separate aircraft transceiver/antenna 14 even though this would add undesirable weight to the aircraft. Gould is in this manner indicative of the "accepted wisdom in the art" at the time of Applicant's invention, and provides clear "evidence of nonobviousness" of the present invention, as claimed.

In the present case, the Examiner has acknowledged that the cited prior art fails to teach each and every claim limitation. Furthermore, the Examiner fails to cite a reference that provides the requisite motivation to modify Robinson to include the claim limitations. In contrast, the cited prior art teaches away from receiving software updates over ADS-B or UAT datalink receivers as presently claimed. Therefore, there is no teaching or suggestion of the specific claim limitation, nor is there any motivation for modification of Robinson, both of which are required to establish *prima facie* obviousness. Thus, the present obviousness rejections are improper, are traversed, and cannot be sustained.

Claim 28 recites "wherein the method further includes providing an authorization code for accessing the radio signal". Claim 29 recites "wherein said providing said authorization code includes ***providing an authorization code to an avionics device that allows the avionics device to receive the update information***", emphasis added. Claim 30 recites "wherein said providing said authorization code includes ***providing an authorization code within the radio signal that allows the avionics device to receive the update information***", emphasis added. Claim 31 recites "wherein said providing said authorization code includes ***providing an authorization code to the device that allows***

the remote transmitter to transmit the update information", emphasis added. Claim 32 recites "wherein said transmitting said radio signal having update information therein includes transmitting a radio signal at ***a private frequency restricted to devices authorized to access the private frequency***", emphasis added.

In rejecting these claims, on page 2 of the November 3, 2006 Office Action, the Examiner mistakenly points to pages 4 and 5 of Gould. Pages 4 and 5 disclose an "aircraft actual configuration identity (AACI)", an "authorized configuration identity file", and a "unique part number or identifier" each of which identifies a configuration, not a user. Thus, these identifiers simply cannot be used in the manner claimed and therefore simply cannot anticipate the claim limitations. Finally, page 6 does speak to authorized users. However, Gould clearly teaches such users logging into his Ground-based Computer System 16, and therefore would not be providing an authorization code to the avionics device itself. Thus, once again, Gould simply cannot anticipate the claim limitations.

The remaining claims all depend directly or indirectly from independent claims 1, 10, 17, 27, and 35, and are therefore also allowable.

Any additional fee which is due in connection with this amendment should be applied against our Deposit Account No. 501-791. In view of the foregoing, a Notice of Allowance appears to be in order and such is courteously solicited.

Respectfully submitted,

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